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Neil D. Scancarella

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EXAMINER

YU, GINA C

ART UNIT

PAPER NUMBER

1611

NOTIFICATION DATE

DELIVERY MODE

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ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/066,005	Applicant(s) SCANCARELLA ET AL.	
	Examiner GINA C. YU	Art Unit 1611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 October 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17, 38 and 41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17, 38, 41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Receipt is acknowledged of amendment filed on October 23, 2009. Claims 17, 38, and 41 are currently pending.

The claim rejections made in the previous Office action dated June 1, 2009 are withdrawn in view of the claim amendment made by applicant. New rejections are made in this Office action to address the new claim limitations.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 17, 38, and 41 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.

The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The October 23, 2009 amendment incorporates claim limitations that are not supported by applicant's original disclosure. Claim 17 requires a lip cosmetic "comprising by weight of the total composition, 44-50 % isododecane, 15-21% trimethylsiloxysilicate, 14-20 % dimethicone". The instant ranges of the active ingredients are not disclosed in the specification. Although applicant asserts specific portions of the instant specification support the new limitations, the disclosure there

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merely indicate general, broad weight range of the ingredients, rather than the specific numeral range that are now recited in the present claims. For example, paragraphs [0043] of the pre-grant publication teaches either volatile or non-volatile solvents are typically used "1-98 %, preferably 2-95%, more preferably 15-85% by weight of the total composition". There is no disclosure for 44-50 % or 14-20 % weight range for the solvent(s). Similarly, paragraph [0034] disclose that polymeric film formers are generally and typically used in "0.1-50 %, preferably 0.5049%, more preferably 1-35% by weight of the total composition". The "15-21%" weight range is not found in the original disclosure. Therefore, the present claim limitation introduces new matters to the present application.

The remaining claims are rejected as they depend on the base claim which fails to meet the written description requirement.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 17, 38, 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Drechsler et al. (US 6074654) in view of Manufacturing Chemists ("New uses for old colour materials", June 1, 1999), ExxonMobile Chemical Technical Data, and Collin (US 6641821 B1).

Claim 17 is directed to "a lip cosmetic comprising an anhydrous pigmented transfer-resistant, film forming, cross-linked resinous silicone, composition, comprising by weight of the total composition, 44-50 % isododecane, 15-21 % trimethylsiloxysilicate,

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14-20% dimethicone of 500,000 cSt coated with a non reactive wetting agent. . . " It appears that the claimed subject matter is the coated layers of two separate compositions, i.e., the film forming composition and the wetting agent.

Drechsler discloses a lip color film-forming composition comprising crosslinked organosiloxane resins such as Wacker 803 from Wacker Silicones Corp. (trimethylsiloxysilicate) and pigments in a volatile carrier. See col. 7, line 46 - col. 9, line 2. The reference also discloses a method of enhancing the gloss, shine, and feel of lip composition by apply a complimentary product, known as "overcoat" or "topcoat", over the film formed after application of a transfer-resistant lip composition. See col. 10, line 63 - col. 16, line 7. The reference teaches that the overcoating composition can be liquid or solid and include "any that are commercially available or to be developed, provided the aggregate of the materials comprising the overcoat does not significantly disrupt" the film-forming composition. See col. 11, line 64 - col. 12, line 29. The reference also teaches in col. 2, lines 7-13 that it is well known in the art to formulate a transfer-resistant cosmetic composition with trimethylated silica and volatile solvent. The reference teaches using the film forming silicone resin in the amount ranging from 10 to 95 %. Example 17 comprises 22.14% of the silicone resin, 57.90 % of isododecane, and 13.86 % of dimethicone having 100,000 cSt. The difference of the weight amount of the components would have been obviously achieved by routine experimentations to make an effective transfer-free lip coloring composition. Drechsler teaches using silicone fluids of viscosity ranging from 100,000-1,000,000 cSt, rendering applicant's dimethicone obvious. See col. 8, lines 13 – 19. Furthermore, both the prior

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art and applicant's invention are open to include oily gelling agent or silicone gum to adjust the viscosity of the silicone fluid or the oil phase of the composition. Thus, criticality of the selection of the viscosity of the silicone fluid is unclear.

Drechsler does not specifically teach the wetting agent of the present claims.

Manufacturing Chemists teaches polyalpha olefins (notably polydecene) are popular oil-free emollients and "pigment wetting and dispersing aids", known for a recommended replacement for mineral oil. These emollients are "colourless, odourless, non-toxic and non-greasy and blend well with most cosmetic oils". The reference teaches the products under PureSyn trademark from Mobil Chemicals and Arlamol brand by Uniquema are available in different viscosity grades.

According to Exxon Mobile Chemical, PureSyn polyalphaolefins are hydrogenated hydrocarbon fluid. The reference teaches PureSyn 150 and 300 having number average molecular weights of 3,500 and 5,100, respectively.

Collin teaches polyalpha olefin wax has been used in film-forming, transfer-free make up compositions. The reference teaches the film-forming compositions contain polyalpha olefin wax, at least one volatile hydrocarbon oil, a film-forming polymer, and liquid fatty phase. See col. 2, lines 16 - col. 3, line 34. The reference teaches the film obtained from the composition is stable and exhibits a good hold; resistant to water, to rubbing, to perspiration. See col. 1, lines 50 – 62. The application of the transfer-resistant composition comprising polyolefin wax encompasses lip products. See col. 2, lines 4 – 8.

It would have been obvious to one of ordinary skill in the art at the time of the present invention to modify the teachings of Drechsler by substituting the overcoat product with polyalpha olefins as motivated by Manufacturing Chemist because the latter teaches polyalpha olefins are popular oil-free emollients and pigment wetting agent which are also colorless, odorless, non-toxic and non-greasy, and blends well with most cosmetic oils. The skilled artisan would have had a reasonable expectation of successfully producing an overcoat product for the transfer-free lip composition because Drechsler teaches the overcoating composition can be liquid or solid and should not significantly disrupt" the film-forming composition, and Collin teaches poly alpha olefins are already known to be comparable with film-forming transfer-free.

Oath/Declaration

Declaration filed under 37 C.F.R. 132.2 on October 23, 2009 has been fully considered, but does not place the present application in allowable condition.

The declaration presents a comparison test between two sets of compositions comprising components in different weight ranges. The composition on the left two columns on page 1 of the declaration is said to represent Drechsler lip color composition and contains 50-55 % of isododecane, 17-23 % of trimethylsiloxysilicate, 9-15 % of dimethicone having viscosity greater than 1M cSt, etc. However, Drechsler also teaches compositions outside of the formulation described in application declaration: for instance, Example 15 contains 8.90 or organosiloxane resin, 57.90 % isododecane, 11.10 % of dimethicone fluid having 100,000 cSt. Thus, declarant's

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designation of the Drechsler composition to employ only viscous dimethicone is inaccurate representation of the prior art.

For above reasons, the declaration does not overcome the obviousness rejections.

Response to Arguments

Applicant's arguments filed on October 23, 2009 have been fully considered but they are moot in view of the new grounds of rejections discussed above.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US 5177277, teaching hydrogenated polybutene copolymer useful in cosmetics including lip gloss.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to GINA C. YU whose telephone number is (571)272-8605. The examiner can normally be reached on Monday through Thursday, from 8:00AM until 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sharmila Landau can be reached on 571-272-0614. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/GINA C. YU/
Primary Examiner, Art Unit 1611

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